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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,984	01/29/2004	Jeremy R. Ziegler	DC-05956	4346

33438 7590 02/23/2010

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ART UNIT	PAPER NUMBER
2193	

NOTIFICATION DATE	DELIVERY MODE
02/23/2010	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEREMY A. ZIEGLER and BRUCE A. ZABAVA

Appeal 2009-004222
Application 10/766,984
Technology Center 2100

Decided: February 19, 2010

Before JAMES D. THOMAS, JOSEPH L. DIXON, and JAY P. LUCAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 10-18. Appellants have cancelled claims 1-9, 19, and 20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

II. INVENTION

Appellants' invention is best described in this manner:

> Claim 10 recites a method that updates an operating system without running the operating system. The source file of the operating system is removed (Figure 2, element 40), the update file is extracted from the operating system update (Figure 2, element 42), the update file is written over the corresponding operating system file (Figure 2, element 44), the operating system is booted (Figure 2, element 48) and the update is registered (Figure 2, element 50; page 6, line 29-page 7, line 15).

(App. Br. 2).

III. REPRESENTATIVE CLAIM

> 10. A method for creating an operating system image, the image having integrated updates, the method comprising:
>
> removing the source file of the operating system;
>
> extracting an update file from an operating system update;
>
> writing the update file over a corresponding operating system file;
>
> booting the operating system; and
>
> registering the update with the operating system.

IV. PRIOR ART AND EXAMINER'S REJECTIONS

The Examiner relies on the following references as evidence of anticipation and unpatentability:

Murray	7,000,230 B1	Feb. 14, 2006 (filed Jun. 21,2000)
Goodman	7,146,640 B2	Dec. 5, 2006 (filed Sep. 5, 2003)

Claims 10, 11, 13, and 15-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Goodman. In a first stated rejection under 35 U.S.C. §103, the Examiner relies upon Goodman alone as to claim 14. Lastly, in the second rejection under 35 U.S.C. §103 as to claim 12, the Examiner relies upon Goodman in view of Murray.[1]

V. CLAIM GROUPINGS

Based upon Appellants arguments in the principal Brief on appeal, we will decide this appeal on the basis of independent claim 10. This claim is representative of all claims on appeal and no arguments are presented in the principal brief on appeal regarding the first and second stated rejections under 35 U.S.C. §103. No dependent claims are argued.

[1] The bottom of page 2 of the Answer correctly indicates that because claims 1-9, 19, and 20 have been cancelled, the corresponding rejections of them have been rendered moot. As such, they are not treated in this opinion.

VI. ISSUE

Have Appellants shown that the Examiner erred in finding that Goodman teaches the feature of "extracting an update file from an operating system update," as recited in representative independent claim 10 on appeal?

VII. FINDING OF FACT

With respect to the showing in disclosed Figure 2, the paragraph bridging pages 6 and 7 of the Specification as filed indicates "at step 42, the update is packaged with a file and directory structure that replaces operating system files with corresponding updated files extracted from one or more operating system updates."

VIII. PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

IX. ANALYSIS

The brief arguments presented at page 3 of the principal Brief on appeal do not contest what the Examiner has correlated to the features recited in representative independent claim 10 on appeal except the clause we reproduced in our issue statement earlier in this opinion. The Examiner has provided extensive details of all features recited in independent claim 10 on appeal at pages 3 and 4 of the Answer, which are significantly expanded upon in the Examiner's responsive arguments beginning at page 7 through the end of the Answer.

Essentially, it appears to us what the Examiner is saying in these comprehensive positions is that Goodman teaches copying an operating system and all its included update files to provide an additional operating system. Moreover, the Examiner has isolated certain teachings in Goodman that indicate the capability of copying, loading, or otherwise updating different/all types of files. These functionalities are consistent with our Finding of Fact indicating that the argued feature of "extracting" simply amounts to a copying, updating, replacing functionality.

Additionally, the Examiner has gone further to indicate that the user in Goodman may select certain copying or duplicating functions, thus, in a different sense, indicating teachings that correlate to the "extracting" functionality as argued. Claim 10 does not exclude the Examiner's interpretations of the reference, nor does this claim exclude the user interaction or selectability feature. Essentially, the reference to Goodman teaches more than what is claimed and does so in a very comprehensive manner.

Therefore, we find that the actual teachings relied upon by the Examiner in Goodman indicate to one of ordinary skill in the art that the claimed extraction function, even though disclosed in Goodman in different words than as claimed, is anticipated by this reference notwithstanding that the subject matter is argued not to be present in Goodman. It appears to us that page 3 of the principal Brief and page 1 of the Reply Brief take the position that there is no explicit or *ipsis verbis* teaching in Goodman that directly, on a one to one basis, corresponds with the actual wording of the claim. Even if we were to agree with this position, the evidence the Examiner has provided in Goodman and the corresponding arguments associated with the Examiner's positions indicate that the comprehensive teachings of Goodman include the claimed feature of extracting update information as well as any selectable file information from an operating system, including update files that may exist there.

The middle of page three of the principal Brief makes note as to what Goodman teaches at column 2, lines 64-66. What Goodman actually teaches here is "because the present invention's inventive software technology is not database driven it does not require malicious code definition updates." What a person of ordinary skill in the art would appreciate is that if these updates, and any "updates" are present in an original operating system, they would be copied or otherwise duplicated and extracted from the original operating system as argued by the Examiner. By its broad, inclusive terms, Claim 10 includes all "updates."

X. CONCLUSION AND DECISION

Appellants have not shown that the Examiner erred in finding that Goodman teaches "extracting an update file from an operating system update," as recited in representative independent claim 10 on appeal. All claims on appeal are unpatentable.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

nhl

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